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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,699	11/19/2003	Chris Concannon	P/4279-4	8860
2352 7590 09/10/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER OSMAN, RAMY M	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/717,699

Applicant(s)

CONCANNON, CHRIS

Examiner

Ramy M. Osman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Status of Claims*

1. This action is responsive to application filed on November 19, 2003. Claims 1-30 are pending examination.

### *Drawings*

2. The drawings filed on 11/19/2003 are acknowledged and are objected to. Some of the figures are blurry or contain unreadable text. Formal drawings will be required upon issuance of the pending application.

### *Claim Objections*

3. Last line of claim 14, remove "of". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-21 rejected under 35 U.S.C. 102(b) as being Smith by (US Patent No 6,192,407).**
6. In reference to claim 1, Smith teaches a system for disseminating an electronic material over a network, the system comprising:

a list defining module that defines a list of at least one intended recipient of the electronic material (column 13 lines 19-45);

an electronic materials receiving module that receives and stores the electronic material from a user to be transmitted to the at least one intended recipient on a site processor (column 15 lines 27-34);

a properties association module that defines properties to be associated with the electronic material (column 15 lines 27-45);

a generate and send message module that provides a message to the at least one intended recipient, wherein the message includes a hyperlink to the electronic material (column 15 lines 4-15); and

a system tracking module that tracks whether the at least one intended recipient receives the electronic material (column 15 lines 17-20 & 45-67).

7. In reference to claim 2, Smith teaches the system of claim 1, further comprising a user management module that is used by the user to allow additional users to disseminate at least one of the electronic material and other electronic material (column 16 lines 5-20).

8. In reference to claim 3, Smith teaches the system of claim 2, wherein the user management module provides various levels of authorization for the additional users (column 16 lines 40-67).

9. In reference to claim 5, Smith teaches the system of claim 1, further comprising a project module that identifies the message, the electronic material and the at least one intended recipient with a unique project name (column 15 lines 15-67).

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10. In reference to claim 6, Smith teaches the system of claim 5, wherein the project module further enables a user to duplicate at least one of the message, the electronic material and an identifier of the at least one intended recipient associated with the unique project name (column 13 lines 19-45).

11. In reference to claim 8, Smith teaches the system of claim 1, wherein the message includes a control for forwarding the message to another intended recipient when the party who receives the message is not one of the at least one intended recipient (column 17 lines 35-45).

12. In reference to claim 9, Smith teaches the system of claim 1, wherein the list includes at least one respective e-mail address for the at least one intended recipient (column 15 lines 1-15).

13. In reference to claim 10, Smith teaches the system of claim 9, further comprising a checking module that tests the at least one e-mail address for accuracy (column 15 lines 1-15) .

14. In reference to claim 11, Smith teaches the system of claim 10, wherein the at least one e-mail address is accurate when the at least one e-mail address complies with formatting standards (column 15 lines 1-15).

15. In reference to claim 12, Smith teaches the system of claim 1, wherein the list defining module further receives electronic e-mail list information, the e-mail list information representing intended recipients and e-mail addresses thereof (column 15 lines 1-15).

16. In reference to claim 13, Smith teaches the system of claim 12, wherein the list defining module creates an e-mail list based on the electronic e-mail list information (column 15 lines 1-15).

17. In reference to claims 14-16,18,19 & 21-26, these claims are method claims that correspond to the system claims of claims 1-3,5,6 & 8-13. Therefore, claims 14-16,18,19 & 21-26 are rejected based upon the same rationale as given for claims 1-3,5,6 & 8-13 above.

18. In reference to claims 28-30, these claims are method claims that correspond to the system claims of claims 1-3. Therefore, claims 28-30 are rejected based upon the same rationale as given for claims 1-3 above.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 4,7,17,20 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith by (US Patent No 6,192,407) in view of Applicant Admitted Prior Art (Patent Publication No 2004/0158612).**

21. In reference to claims 4 and 7, Smith teaches the system of claim 1. Although Smith fails to explicitly teach wherein the electronic material comprises at least one of annual reports, bank books, compliance documents, litigation-related materials, mutual fund related information, Preliminary Official Statements, private placements, prospectuses, proxy statements, registration statements and research reports; Applicant has admitted to this being old and well-known in the art (see ¶ 7). It would have been obvious for one of ordinary skill in the art to modify Smith wherein the electronic material comprises at least one of annual reports, bank books, compliance

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documents, litigation-related materials, mutual fund related information, Preliminary Official Statements, private placements, prospectuses, proxy statements, registration statements and research reports as admitted to by applicant for the purpose of utilizing it in the financial investment industry.

22. In reference to claims 17 & 20, these claims are method claims that correspond to the system claims of claims 4 & 7. Therefore, claims 17 & 20 are rejected based upon the same rationale as given for claims 4 & 7 above.

### *Conclusion*

23. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the above specified citations of the relied upon prior art are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and priority documents) is implied as being applied to teach the scope of the claims.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO  
September 4, 2007

  
ARIO ETIENNE  
SUPERVISOR, PATENT EXAMINER